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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,099	10/03/2007	Jeung-Yeup Son	038779/314156	1742
826	7590	07/21/2010	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			HUANG, TSAN-YU J	
			ART UNIT	PAPER NUMBER
			3685	
			MAIL DATE	DELIVERY MODE
			07/21/2010	PAPER

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The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Acknowledgements

This Office Action is in response to the application filed on May 6, 2010.

The Examiner notes that United States Patent Application Publication paragraph numbers in the Office Action will be referred to as [####], #### representing the paragraph number.

The Examiner notes that an ellipsis (...) marks an intentional omission of a phrase from the original text, and is not shorthand for the actual phrase.

The Examiner notes that the usage of "etc" marks a continuation of the phrase from the original text.

Status of Claims

Claims 6-11, 13-20 are withdrawn from consideration.

Claims 21-24 are new.

Claims 1-24 are currently pending.

Claims 1-5, 12, 21-24 are rejected as set forth below.

Response to Arguments

Applicant's argument #1

Applicant contends the rejections of **Claims 1-5, 12** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as set forth in the previous Office Action, are obviated.

Examiner's response #1

Applicant's arguments, see Applicant's argument #, with respect to claims 1-5 have been fully considered but they are not persuasive. The rejection is maintained.

Applicant's arguments, see Applicant's argument #1, with respect to claim 12 have been fully considered and are persuasive. The rejection has been withdrawn.

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Applicant's argument #2

Applicant contends the rejections of **Claims 1-5** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as set forth in the previous Office Action, are obviated.

Examiner's response #2

Applicant's arguments, see Applicant's argument #2, with respect to claim 1 have been fully considered but they are not persuasive. The rejection (software components in a system, scope unclear) is maintained.

Applicant's arguments, see Applicant's argument #2, with respect to claims 2 have been fully considered and are persuasive. The rejection (hybrid claim) has been withdrawn.

Applicant's arguments, see Applicant's argument #2, with respect to claims 3, 5 have been fully considered but they are not persuasive. The rejections (hybrid claim) are maintained.

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Applicant's argument #3

Applicant contends the rejections of **Claims 1-2, 4, 12** under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No. 2003/0191721 to *Fiammante*, in view of United States Patent Application Publication No. 2001/0037264 to *Husemann*, as set forth in the previous Office Action, are improper.

Examiner's response #3

Applicant contends *Fiammante* fails to disclose “a transaction history, let alone receiving, transmitting, and/or receiving a digitally signed transaction history”. The Examiner respectfully disagrees. *Fiammante* contends there is no mention of a transaction history, specifically a historical record of multiple individual transactions. However, as disclosed in [0026] – [0030] of *Fiammante*, the “contents of the transaction” or “transaction data” represents the transaction history, as it is disclosed as a virtual shopping cart filled with individual items to be purchased. The “transaction data” is further shown to be received, transmitted, and digitally signed ([0026] – [0030]).

In addition, Applicant contends *Fiammante* fails to disclose “verifying a digitally signed transaction history to provide a service corresponding to a transaction that was requested.” The Examiner respectfully disagrees. As disclosed in [0020] – [0022], [0033] of *Fiammante*, after the transaction history is verified, the business application and servlet completes the transaction, the transaction representing the service.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-5** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. **Regarding claim 1**, the claimed invention discloses an electronic transaction system that includes a certifier which can be interpreted as a human being. If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. See *MPEP* §2105. The rejection applies to dependent **claims 2-5**.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. **Regarding claim 1**, the claimed invention discloses an electronic transaction system whose scope is unclear. While the system is presumed to be a machine, the “message sender”, “transaction history sender”, “certifier”, and “service provider”, given the broadest reasonable interpretation, are interpreted as software. It is unclear how the scope of the claim can be determined if it is not disclosed where the “message sender”, “transaction history sender”, “certifier”, and “service provider” are physically stored and how the structure on which the “message sender”, “transaction history sender”, “certifier”, and “service provider” are realized on are integrated with the other components of the system. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. See *Lowry*, 32 F.3d at 1583-84, 32 U.S.P.Q. 2d at 1035. The rejection applies to dependent **claims 2-5**.

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4. **Regarding claim 1**, the invention purports to be both a product or machine and a process and therefore is ambiguous. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved . For example, the limitation “wherein the transaction processor inquires about a certification method, etc”, “provide the transaction history to the certification mobile terminal after the certification mobile terminal receives, etc”, and "provide a service corresponding to the transaction to the transaction terminal after the digitally signed transaction history is verified, etc” are method steps. See *MPEP 2173.05(p) II; IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

5. **Regarding claim 3**, the invention purports to be both a product or machine and a process and therefore is ambiguous. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved . For example, the limitation “wherein the certification mobile terminal receives a digital certificate, etc.” is a method step. See *MPEP 2173.05(p) II; IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

6. **Regarding claim 5**, the invention purports to be both a product or machine and a process and therefore is ambiguous. It has been held that a claim that recites both an

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apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved . For example, the limitation “wherein the message sender transmits, etc.” is a method step. See *MPEP 2173.05(p) II; IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-2, 4-5, 12, 21, 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No. 2003/0191721 to *Fiammante*, in view of United States Patent Application Publication No. 2001/0037264 to *Husemann*.

9. **Regarding claims 1 and 12**, *Fiammante* teaches:

An electronic transaction system, being connected to a transaction terminal and a certification mobile terminal through a network and performing transactions according to a user request, comprising:

a transaction processor configured to perform a transaction according to a request provided by the transaction terminal; (Figure 1, [0020] – [0022])

a message sender configured to receive a transaction history for settling the transaction provided by the user... from the transaction terminal and a mobile phone number, and configured to transmit a message which notifies receipt of the transaction history to the certification mobile terminal corresponding to the mobile phone number; (Figure 1-2, [0026] – [0030])

a transaction history sender configured to provide the transaction history to the certification mobile terminal...; (Figure 1-2, [0026] – [0031])

Fiammante does not explicitly disclose providing data to a terminal when the terminal performs an access on the data sender. However, the Examiner takes Official Notice that providing data to a terminal when the terminal performs an access on the data sender is old and well known. Therefore, as *Fiammante* teaches providing data to a terminal, a predictable result would have been to provide data to the terminal when the terminal performs an access in order to provide the data only when the terminal requests it.

a certifier configured to receive a digitally signed transaction history from the certification mobile terminal, and verify the digitally signed transaction history; (Figure 1-2, [0031] – [0033]) and

a service provider configured to provide a service corresponding to the transaction to the transaction terminal after the digitally signed transaction history is verified. (Figure 1, [0020] – [0022]; [0033])

Furthermore, a recitation of the intended use of the claimed invention (i.e. the transaction processor/message sender/transaction history sender/certifier/service

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provider configured to perform an action) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

Fiammante does not explicitly teach receiving a mobile phone number from the transaction terminal.

However, *Husemann* teaches receiving a mobile phone number from the transaction terminal. (Figure 4, [0054])

One of ordinary skill in the art at the time of the invention would have been motivated to modify *Fiammante* with the features taught by *Husemann* because modifying the message sender to receive the mobile phone number from the transaction terminal ensures that the customer's most current mobile phone number is used, thus increasing the overall quality of service of the invention.

10. **Regarding claims 2 and 21**, *Fiammante* and *Husemann* disclose the invention as claimed. See the discussion of claim 1.

Fiammante further teaches transmitting the transaction history to the certification mobile terminal. (see the discussion of claim 1)

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In addition, *Husemann* further teaches:

a history database configured to store mobile phone number and corresponding transaction histories for respective users, wherein the transaction history sender is configured to use the mobile phone number of the certification mobile terminal to find a corresponding transaction history from the history database. ([0065])

Furthermore, a recitation of the intended use of the claimed invention (i.e. the history database/transaction history sender configured to perform an action) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

11. **Regarding claims 4 and 23**, *Fiammante* and *Husemann* disclose the invention as claimed. See the discussion of claim 1.

Applicant attempts to further limit the electronic transaction system by describing characteristics of the message. However, this is representative of non-functional descriptive material as characteristics of the message is not functionally related to the electronic transaction system (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's invention from the prior art invention.

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12. **Regarding claims 5 and 24**, *Fiammante* and *Husemann* disclose the invention as claimed. See the discussion of claim 1.

Husemann further teaches:

wherein the message sender transmits the message in the short message services (SMS) or multimedia messaging service (MMS) format. ([0070] – [0072]; [0081] – [0085])

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13. **Claims 3, 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No. 2003/0191721 to *Fiammante* in view of United States Patent Application Publication No. 2001/0037264 to *Husemann*, and further in view of United States Patent Application Publication No. 2002/0198849 to *Piikivi*.

14. **Regarding claims 3 and 22**, *Fiammante* and *Husemann* disclose the invention as claimed. See the discussion of claim 1.

None of the references explicitly teach:

a certification authority server configured to issue digital certificates, wherein the certification mobile terminal receives a digital certificate from the certification authority server.

However, *Piikivi* teaches:

a certification authority server configured to issue digital certificates, wherein the certification mobile terminal receives a digital certificate from the certification authority server. ([0044] – [0045])

Furthermore, a recitation of the intended use of the claimed invention (i.e. the certification authority server configured to perform an action) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

One of ordinary skill in the art at the time of the invention would have been motivated to modify *Fiammante* and *Husemann* with the features taught by *Piikivi* because modifying the electronic transaction system to include a certification authority server for issuing digital certificates ensures the alleged parties are indeed who they say they are, thus increasing the security of the invention.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

The reference *Ginter* (United States Patent Application Publication No. 2002/0112171) discloses providing data to a terminal when the terminal performs an access on the data sender.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TSAN-YU JAY HUANG whose telephone number is (571)270-7039. The examiner can normally be reached on Monday to Friday, 9:00 am - 5:00 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TSAN-YU J HUANG/
Examiner, Art Unit 3685
July 14, 2010

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685